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Docket No. 4733

IN THE UNITED STATES PATENT & TRADEMARK OFFICE



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7-24-95

Applicants: Eugene P. GOLDBERG, ET AL
Serial No.: 08/141,017
Filed: October 26, 1993
For: METHOD OF AND COMPOSITION FOR
PREVENTING TISSUE DAMAGE
Art Unit: 1502
Examiner: Edward J. Webman

RESPONSE TO OFFICIAL LETTER

Hon. Commissioner of Patents & Trademarks
Washington, D.C. 20231

Sir:

In response to the Official Letter mailed April 18, 1995, please reconsider the above-captioned application in light of the following remarks.

REMARKS

The rejection of claims 1, 2 and 5-10 under 35 USC §102(e) as anticipated by Lindblad et al is respectfully traversed.

First, Lindblad is not available as prior art against the claims of the present application inasmuch as the Lindblad patent issued on March 2, 1993, based on International Application No. PCT/SE 90/00117 bearing a §102(e) date of October 22, 1990. The present application is ultimately derived from application Serial No. 07/199,687 filed May 31,

1988. Inasmuch as the effective filing date of the present application pre-dates the effective date of the Lindblad et al patent by more than two (2) years, the latter is not available as prior art against the claims of the present application.

Secondly, Lindblad et al relate to methods and compositions for the prevention of adhesions between body tissues by applying the active composition to the body tissues post-operatively. The present claims are directed to a method for protecting tissues by applying the hyaluronic acid composition prior to surgery or manipulation of the tissues and surfaces involved in the surgery. Inasmuch as the claims under rejection clearly distinguish over the method disclosed by Lindblad et al, withdrawal of this ground of rejection is respectfully requested.

It is further noted that parent application Serial No. 07/555,377 filed July 19, 1990, ultimately issued as U.S. Patent No. 5,080,893. The Examiner previously rejected the present claims on the ground of obviousness-type double patenting based on the prior issued patent noted above. A Terminal Disclaimer was filed to overcome this ground of rejection. The Examiner should note, however, that the claims of the prior patent were rejected during prosecution of the application which matured into that patent over prior art which was ultimately distinguished by the fact that the reference was directed to a method for prevention of adhesions post-operatively, whereas the claims of the patent were directed to treatment prior to surgery. Since the Examiner

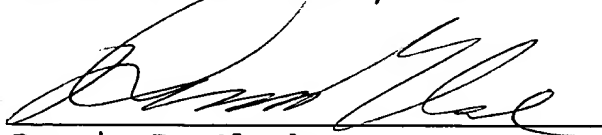
viewed the method of the present invention sufficiently equivalent to that of the prior issued patent to warrant the filing of a Terminal Disclaimer, it would appear that if the claims of the prior patent were patentable over a reference showing post-operative prevention of adhesions, the present claims should similarly be patentable over a reference containing a similar disclosure.

Applicants have earnestly endeavored to place the application in condition for allowance, and an early action toward that end is respectfully requested.

To the extent necessary, applicants petition for an extension of time under 37 CFR §1.136. Please charge any additional fees due (or credit any overpayment thereof) to Deposit Account No. 11-0610 (Docket No. 4733).

Respectfully submitted,

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